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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,430	01/28/2004	Brian L. Gibson	H0003690	3601

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EXAMINER

CHEUNG, WILLIAM K

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,430

Applicant(s)

GIBSON ET AL.

Examiner

William K. Cheung

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 67 and 71-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 67 and 71-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. In view of applicants' comment that new claims 71-85 filed August 19, 2005, in response to the non-final office action of April 14, 2005, have not been examined, claims 71-85 are examined in instant office action. Claims 19-66, 68-70 have been cancelled. Claims 1-18, 67, 71-85 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-18, 67 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaneko et al. (US 3,635,856) as affirmed by product literature of Mitsubishi-Kagaku Food Corporation, copyright 2002 (c) obtained from website <http://www.mfc.co.jp/english/index.htm>.

Kaneko et al. (col. 1, line 42-47; col. 3, line 9-30; col. 4, line 45-60; col. 5, line 25-45; col. 5-6, examples I and II) disclose a process for extruding a resin-containing

Art Unit: 1713

composition comprising: a) providing an extrudable mass comprising at least one extrudable resin and saccharide ester; and b) extruding said extrudable mass to produce an extrudate. As affirmed by product literature of Mitsubishi-Kagaku Food Corporation, copyright 2002 (c), the saccharide ester of Kaneko et al. has a structure that is substantially identical to the saccharide ester of Formula (I) as claimed.

Regarding claims 2-14, Kaneko et al. clearly disclose an amount of saccharide ester for the extruded composition. Regarding the recited "to improve..." of claims 2-14, applicants must recognize that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In view of the reasons set forth above, Claims 1-18, 67 are anticipated.

Response to Arguments

Applicant's arguments filed August 19, 2005 have been fully considered but they are not persuasive. Applicants argue that Kaneko et al. (col. 3, line 73 to col. 4, line 1)

Art Unit: 1713

teach away from highly substituted esters. However, the examiner disagrees because the formula (I) as claimed does not requires all A to be an ester. A could also be hydrogen as well as claimed. Therefore, the Declaration filed August 19, 2005 is inadequate for overcoming the 102(b) rejection set forth.

Regarding applicants' argument that "unexpectedly found desirable properties and other unexpected advantages", applicants fail to recognize that the presentation of "unexpected results" is an effective method for overcoming a 103 rejection, but the presentation of "unexpected results" is ineffective in overcoming a 102(b) rejection.

Applicant's arguments filed December 27, 2005 have been fully considered but they are not persuasive. Applicants argue that the use of the product literature of Mitsubishi-Kagaku Food Corporation as a reference to affirm the structure of the saccharide ester of Kaneko et al. is improper because the structure as shown in the product literature of Mitsubishi-Kagaku Food Corporation is not an octa-ester. However, applicants fail to recognize that the two lines above the chemical disclosed clearly indicate compounds ranging from sucrose mono to octa fatty acid ester can be produced. In view of small number of ester species disclosed, the octa ester feature is inherently possessed in Kaneko et al. Therefore, the 102 rejection set forth is proper.

Regarding applicants' argument that In re Casey and In re Otto is pertained to machinery and therefore not applicable to the invention as claimed because the claimed

Art Unit: 1713

invention is not directed to machinery, the examiner disagrees because "intended use" teachings in *In re Casey* and *In re Otto* are not limited to machinery.

Regarding applicants' argument on HLB ranges, in view of substantially identical composition disclosed in *Kaneko et al.* and the composition as claimed, the examiner has a reasonable basis to believe that the argued HLB is inherently possessed in *Kaneko et al.* Further, the argued HLB values are not supported by the claims.

4. Claims 71-75 are rejected under 35 U.S.C. 102(b) as being anticipated by *Kaneko et al.* (US 3,635,856) as affirmed by product literature of Mitsubishi-Kagaku Food Corporation, copyright 2002 (c) obtained from website <http://www.mfc.co.jp/english/index.htm>.

Kaneko et al. (col. 1, line 42-47; col. 3, line 9-30; col. 4, line 45-60; col. 5, line 25-45; col. 5-6, examples I and II) disclose a process for extruding a resin-containing composition comprising: a) providing an extrudable mass comprising at least one extrudable resin and saccharide ester; and b) extruding said extrudable mass to produce an extrudate. As affirmed by product literature of Mitsubishi-Kagaku Food Corporation, copyright 2002 (c), the saccharide ester of *Kaneko et al.* has a structure that is substantially identical to the saccharide ester of Formula (I) as claimed. *Kaneko et al.* (col. 6, table 1 and 2) clearly disclose compositions comprising polyvinyl chloride.

5. Claims 76-85 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaneko et al. (US 3,635,856) as affirmed by product literature of Mitsubishi-Kagaku Food Corporation, copyright 2002 (c) obtained from website <http://www.mfc.co.jp/english/index.htm>.

Kaneko et al. (col. 1, line 42-47; col. 3, line 9-30; col. 4, line 45-60; col. 5, line 25-45; col. 5-6, examples I and II) disclose a process for extruding a resin-containing composition comprising: a) providing an extrudable mass comprising at least one extrudable resin and saccharide ester; and b) extruding said extrudable mass to produce an extrudate. As affirmed by product literature of Mitsubishi-Kagaku Food Corporation, copyright 2002 (c), the saccharide ester of Kaneko et al. has a structure that is substantially identical to the saccharide ester of Formula (I) as claimed. Kaneko et al. (col. 6, Table 1 and 2) disclose compositions comprising calcium stearate.

Regarding the claim 76 where each R is an aliphatic moiety of about 12 to about 26 carbon atoms, applicants must recognize that the two lines above the chemical structure disclosed clearly indicate compounds ranging from sucrose mono to octa fatty acid ester can be produced. Because fatty acid ester typically have carbons in the range of about 12 to about 26, the examiner has a reasonable basis that this claimed feature is inherently possessed in disclosed structure.

Art Unit: 1713

Regarding claim 83, applicants must recognize that calcium stearate commercially comprises unreacted calcium hydroxide and stearic acid.

Regarding claims 84 and 85, Kaneko et al. (col. 6, line 57-68) clearly disclose a composition comprising oxidized oil and zinc stearate, which is a stabilizer typically for PVC.

In view of the reasons set forth above, Claims 76-85 are anticipated.

Conclusion

6. Applicant's amendment filed August 19, 2005 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 1713

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung, Ph.D.

Primary Examiner

January 12, 2006

**WILLIAM K. CHEUNG
PRIMARY EXAMINER**